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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,719	06/25/2001	Dale W. Malik	BELL-0104/01030	2096

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EXAMINER

NGUYEN, QUANG N

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/888,719

Applicant(s)

MALIK, DALE W.

Examiner

Quang N. Nguyen

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Detail Action***

1. This Office Action is in response to the Application SN 09/888,719 filed on 06/25/2001. Claims 1-16 are presented for examination.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**3. Claims 1-2, 7, 9 and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Bates et al. (US 6,779,021), herein after referred as Bates.**

4. As to claim 1, Bates teaches a method for regulating email, comprising:

receiving an email (*network server 40 receives email from mail domain servers 50a-50n*) (Bates, C6: L12-15);

identifying a source of the email (*prediction application 42 checks to see if a single user address or domain is sending many tailored spam notes to individuals serviced by network server 40*) (Bates, C7: L29-34 and C9: L3-5);

updating aggregate email statistics maintained for the source to reflect receipt of the email (*updating the number of users receiving email, from the same source address during the "B" time period*) (Bates, C9: L3-12);

comparing the aggregate email statistics to target email statistics (*determining whether or not the number of users receiving email from the same source address during the "B" time period is greater than a designated "C" number of recipients, i.e., a designated "C" number of received emails*) (Bates, C9: L3-12);  
and

if the aggregate email statistics are not acceptable in comparison to the target email statistics, taking a remedial action (*if the number of users receiving email from the same source address during the "B" time period is greater than a designated "C" number of recipients, then the process passes to block 120 which is marking the new email as a predicted spam, etc.*) (Bates, C9: L12-16).

5. As to claim 2, Bates teaches the method of claim 1, wherein identifying a source of the email comprises identifying the domain name from which the email was received (Bates, C7: L29-43 and C9: L20-26).

6. As to claim 7, Bates teaches the method of claim 1, further comprising identifying for the source, a corresponding source group (*i.e., the corresponding domain of the sender such as "aol.com" of "user@aol.com"*) having target email statistics (*having a designated "D" number of recipients during the "B" time period*) (Bates, C9: L20-26).

7. Claim 9 is a corresponding computer readable medium claim of method claim 1; therefore, it is rejected under the same rationale.

8. Claim 13 is a corresponding method claim of method claim 1; therefore, it is rejected under the same rationale.

9. Claims 14-15 are corresponding method claims of method claim 1; therefore, they are rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**11. Claims 3-4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates, in view of Dickie et al. (US 6,643,687), herein after referred as Dickie.**

12. As to claims 3-4, Bates teaches the method of claim 1, but does not explicitly teach wherein updating aggregate email statistics maintained for the source to reflect receipt of the email comprises updating a counter of the number of emails received from the source and comparing the counter of the number of emails received from the source to a benchmark value for the counter.

In a related art, Dickie teaches an email system to control access to a recipient's mailbox, including a counter which can be incremented or decremented in order to limit the number of email exchanges for an email address (Dickie, C6:L66 – C7:L2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Bates and Dickie

to include a counter, update and compare the counter of the number of emails received from the source to a benchmark value for the counter since such methods were conventionally employed in the art to regulate the number of email exchanges for a designated email address (Dickie, C6:L66 – C7:L2).

13. Claim 11 is a corresponding method claim of method claim 3; therefore, it is rejected under the same rationale.

**14. Claims 5, 8, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates, in view of Mastrianni (US 2002/0116641 A1).**

15. As to claim 5, Bates teaches the method of claim 1, but does not explicitly teach taking remedial action comprises sending an email to at least one of the postmaster and administrator at the source.

In a related art, Mastrianni teaches a method for providing automatic email filtering based on sender's ID or the IP address from which the email originates, wherein if the email is predicted or determined as spam, then the semantic engine composes a message and sends the message to the administrator of the server from which the offending email originated (Mastrianni, paragraph [0043]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Bates and Mastrianni to take remedial action by sending an email to at least one of the

postmaster and administrator at the source since such methods were conventionally employed in the art to notify the postmaster or the administrator at the source or relay server where the rejected email (spam) originates from so they can also take their own appropriate remedial action (such as disabling the relay).

16. As to claim 8, Bates-Mastrianni teaches the method of claim 1, further comprising:

identifying a profile of acceptable email characteristics (*characteristics such as similar titles, similar contents, particular/designated size of an email*) of emails received from the source;

comparing the email to the profile of the acceptable email characteristics (C9:L34 – C10:L10);

if the email is not acceptable in comparison to the acceptable email characteristics (marked as spam/objectionable/unwanted), notifying at least one of the postmaster and administrator at the source (Mastrianni, paragraph [0043]).

17. Claim 10 is a combination method claim of method claims 1, 5 and 7; therefore, it is rejected under the same rationale.

18. Claim 12 is a corresponding method claim of method claim 8; therefore, it is rejected under the same rationale.



**19. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bates, in view of Greenstein (US 6,266,692).**

20. As to claim 6, Bates teaches the method of claim 1, but does not explicitly teach taking remedial action comprises returning the email to the source.

In a related art, Greenstein teaches a method for blocking and/or filtering email, wherein when the unwanted email is purged, the server may additionally send a reply email back to the sender to not send anymore unwanted emails to this user/server or alternately, the unwanted email maybe be sent back to the sender (Greenstein, C3: L63-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Bates and Greenstein to taking remedial action by returning the email to the source since such methods were conventionally employed in the art to notify the sender (i.e., the source) not to send anymore unwanted (unsolicited) emails to the receiving user/server.

**21. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bates, in view of Nachman et al. (US 2002/0027474 A1), herein after referred as Nachman.**

22. As to claim 16, Bates teaches the method of claim 14, but does not explicitly teach wherein the electronic message is an instant message.

In a related art, Nachman teaches a method and system for sending real-time messages (*i.e., instant messages*) between viewers of a WWW page, wherein the system of the invention employs means for filtering unwanted messages including specific information and/or originating in problematic sources in order to protect legitimate users from misuse of the system by spammers (Nachman, paragraph [0044]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Bates and Nachman to regulate electronic messages wherein the electronic message is an instant message since such methods were conventionally employed in the art to filter out unwanted/unsolicited messages to protect legitimate users from misuse of the system by spammers or problematic sources (Nachman, paragraph [0044]).

23. Further references of interest are cited on Form PTO-892, which is an attachment to this office action.

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24. A shortened statutory period for reply to this action is set to expire THREE (3) months from the mailing date of this communication. See 37 CFR 1.134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (703) 305-8190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for the organization is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Le Hien Luu', with a long horizontal line extending to the right.

LE HIEN LUU  
PRIMARY EXAMINER